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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/954,899	09/18/2001	Bror H. Hanson	1641.00005	8597

7590 08/23/2004

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EXAMINER	
JOLLEY, KIRSTEN	

ART UNIT	PAPER NUMBER
1762	

DATE MAILED: 08/23/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action	Application No.	Applicant(s)	
	09/954,899	HANSON, BROR H.	
	Examiner	Art Unit	
	Kirsten C Jolley	1762	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 09 August 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.

b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☒ A Notice of Appeal was filed on *09 August 2004*. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.

2. ☐ The proposed amendment(s) will not be entered because:

   (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);

   (b) ☐ they raise the issue of new matter (see Note below);

   (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or

   (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

   NOTE: _____.

3. ☐ Applicant's reply has overcome the following rejection(s): _____.

4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).

5. ☒ The a)☐ affidavit, b)☐ exhibit, or c)☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: *see attached action*.

6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.

7. ☒ For purposes of Appeal, the proposed amendment(s) a)☐ will not be entered or b)☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

   The status of the claim(s) is (or will be) as follows:

   Claim(s) allowed: *13 and 14*.

   Claim(s) objected to: _____.

   Claim(s) rejected: *11-12,15-16*.

   Claim(s) withdrawn from consideration: _____.

8. ☐ The drawing correction filed on _____ is a)☐ approved or b)☐ disapproved by the Examiner.

9. ☐ Note the attached Information Disclosure Statement(s)(PTO-1449) Paper No(s). _____.

10. ☐ Other: _____

ADVISORY ACTION

1. Applicant's arguments filed August 9, 2004 have been considered but are not persuasive.

With respect to the obviousness-type double patenting rejections, Applicant argues that the standard for comparison for the second is what was claimed in the first patent, not what was disclosed in the specification of the first patent. The Examiner notes that only the *claims* of the reference to which double patenting is asserted (the "first patent," i.e., the Hanson et al. '026 and '495 references) were used to compare with the claimed invention. The claims of Hanson et al. '026 and '495 merely lack that the solvent base wax material includes about 7 to about 10 weight percent solids. The Urena '251 reference is cited to demonstrate that solvent base wax material having 5-15 wt % wax, and thus 5-15 wt % solids, is conventionally known in the art; the range of 5-15 wt % solids taught by Urena overlaps the range claimed by Applicant. MPEP 804 discloses that the claim in the application at issue is compared to the "patent claim and the prior art." In this case, the claims at issue are compared to the claims of Hanson et al. '026 and Hanson et al. '495, and to the known "prior art" of Urena '251. It is not required that the *claims* of the Urena '251 reference are used as the showing of prior art.

With respect to the 35 USC 103(a) rejections over Hanson et al. '495 in view of Urena, Applicant argues that Hanson et al. '495 does not disclose providing a barrier coating of a substantially liquid wax material, wherein the wax material includes about 7 to about 10 weight percent solids, permitting wax material to substantially dry after

application onto a mold surface, and applying the release powder onto the barrier coating after the wax material has been permitted to substantially dry after application onto the mold surface. The Examiner notes that Hanson et al. teaches providing a barrier coating of a substantially liquid wax material by spraying solvent base wax on the mold surface as disclosed in col. 5, lines 53-61; a solvent base way is a substantially liquid wax material. The Examiner acknowledges that Hanson et al. does not teach the use of a wax material containing about 7 to about 10 weight percent solids. The Urena reference is cited for this teaching. It is the Examiner's position that because Hanson et al. lacks any details about an exemplary solvent base wax composition that may be used in its invention, one having ordinary skill in the art would have been motivated to look to the prior art, such as the Urena reference, for conventional solvent-based wax coating materials that may be used as the mold release coating composition in Hanson et al.'s mold coating process.

Hanson et al. does not specifically state that substantial drying of its solvent base wax material occurs prior to applying the release powder thereon. However, Hanson et al. states: "Periodically, such as once every ten parts, a normal application of solvent base wax is sprayed on the mold. Just before pouring each part, the release powder is electrostatically deposited on the base coating in the mold, generally 0.5 to 2 g." Therefore, in 9 of every 10 applications, the release powder is necessarily applied to a substantially dried wax layer because Hanson et al. teaches that the wax layer remains on the interior of the mold throughout the 9 completed molding operations. The solvent from the solvent-base wax would have necessarily evaporated from the barrier coating throughout the 9 molding operations, particularly since molding occurs at elevated

temperatures. Additionally, even on the first application of solvent base wax, the use of the phrase "Just before" indicates that application of the release powder does not occur immediately after applying the wax coating layer. Further, with respect to the combination of Hanson et al. '495 and Urena, Urena states that its solvent is selected to provide "rapid evaporation" and "quickly evaporates" (col. 3, lines 64-67 and col. 5, lines 1-2), therefore the solvent in the solvent base wax coating would quickly evaporate from the wax coating layer after application, thus leaving a *substantially* dry coating prior to application of the release powder.

Applicant argues that Urena does not disclose providing a barrier coating of a substantially liquid wax material, wherein the wax material includes about 7 to about 10 weight percent solids, permitting wax material to substantially dry after application onto a mold surface, and applying the release powder onto the barrier coating after the wax material has been permitted to substantially dry after application onto the mold surface. The Examiner notes that the Urena reference is cited *merely* for its teaching of a known and exemplary solvent-based wax coating material that is sprayable and may be used for providing a release coating on molds (col. 2, lines 23-36, col. 4, lines 51-53, and col. 5, lines 15-25), and which may be used as an exemplary solvent base wax material in the Hanson et al. '495 process. Urena teaches that the wax is included in an amount of about 5-15% by weight. Since Urena teaches that the only essential ingredients of its composition are wax and solvent, the range of 5-15 wt % weight corresponds to 5-15 wt % wax solids. Overlapping ranges are *prima facie* evidence of obviousness. It would have been obvious to one having ordinary skill in the art to have selected the portion of Urena's weight percent wax solids range that corresponds to the claimed range. *In re*

Malagari, 184 USPQ 549 (CCPA 1974). Additionally, Urena teaches in Table I (col. 5) that 10 % by weight of microcrystalline wax is used when the wax-containing coating is used as a mold release coating for polystyrene foam. Therefore, Urena discloses a substantially liquid wax material wherein the wax material has weight percent solids in the range of 5-15 wt %, which overlaps the claimed range of 7-10 wt %, and specifically 10 wt % when used as a mold release coating for polymeric foam.

2. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kirsten C Jolley whose telephone number is 571-272-1421. The examiner can normally be reached on Monday to Thursday and every other Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Shrive P Beck can be reached on 571-272-1415. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Kirsten C Jolley
Patent Examiner
Art Unit 1762

kcj